

Response to Office Action Mailed October 17, 2005
Patent 09/878,009

RESPONSE

Claims 1-41 are pending in the application. Claims 1, 19, 27 and 39 are independent format.

Section 102(e) Rejection

Claims 1-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Scott et al. U.S. Patent No. 5,675,752. The Applicant traverses all of the Examiner's assertions. The Applicant may only respond to specific portions of the Examiner's assertions but intends to traverse all of the Examiner's assertions.

Section 102(e) Response

CLAIM 1:

Claim 1 has been amended to further clarify the invention. Scott does not teach at least the claim elements of Claim 1 including:

capturing one or more graphical representations of portions information content of one or more computer files while an application is manipulating the one or more computer files and creating an icon including selected portions of the one or more captured graphical representations of the information content of the one or more computer files, wherein the icon graphically depicts at least a portion of the information content from the one or more computer files.

The Examiner is reminded that *a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently*

11 of 13

LESAVICH HIGH-TECH
LAW GROUP, P.C.
SUITE 320
30 SOUTH LA SALLE STREET
CHICAGO, ILLINOIS 60603
TELEPHONE (312) 332-3751

Response to Office Action Mailed October 17, 2005
Patent 09/878,009

described in a single prior art reference. Verdegall Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1997). Scott clearly does not describe each and every element of Applicant's Claim 1, either expressly or inherently and therefore cannot anticipate Applicant's Claim 1 for the following reasons.

Scott simply does not teach, expressly or inherently capturing graphical representations of portions of the information content of computer files as the computer files are being manipulated and using the captured graphical representations of the information content to create a graphical icon that includes the graphical representations and can be used to invoke the files. Thus, Scott cannot anticipate the claimed invention under the holding of *Verdegall Bros.*

CLAIMS 2-41:

The arguments for independent Claim 1 above are incorporated by reference for the other independent claims and dependent Claims 2-41. Claims 2-41 include additional limitations not recited by Claim 1. The Examiner is reminded that if an independent claim is not anticipated, then any claim depending there from is also not anticipated. Since Claim 1 is not anticipated by Scott, claims 2-41 cannot be anticipated by Scott. Thus, the 102(e) rejections for these claims are also improper and should be immediately be withdrawn.

12 of 13

LESAVICH HIGH-TECH
LAW GROUP, P.C.
SUITE 220
39 SOUTH LASALLE STREET
CHICAGO, ILLINOIS 60603
TEL/PHONE (312) 332-3751

Response to Office Action Mailed October 17, 2005
Patent 09/878,009

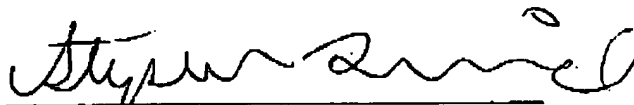
CONCLUSION

The prior art made of record in the Office Action but not relied upon by the Examiner is no more pertinent to Applicant's invention than the cited reference for the reasons given above. The Applicant therefore submits that all of the claims in their present form are immediately allowable and requests the Examiner withdraw the §102(e) rejections of Claims 1-41 and pass all of the claims to allowance.

Respectfully submitted.

Lesavich High-Tech Law Group, PC (32097)

Dated: April 17, 2006


Stephen Lesavich, PhD

Reg. No. 43,749

13 of 13

LESAVICH HIGH-TECH
LAW GROUP, P.C.
SUITE 325
39 SOUTH LA SALLE STREET
CHICAGO, ILLINOIS 60603
TELEPHONE (312) 332-3751